



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/696,030

10/30/2003

Hiroyuki Nagano

402847

9435

23548 7590 08/11/2008

LEYDIG VOIT & MAYER, LTD
700 THIRTEENTH ST. NW
SUITE 300
WASHINGTON, DC 20005-3960

EXAMINER

PANDYA, SUNIT

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

08/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/696,030	Applicant(s) NAGANO, HIROYUKI	
	Examiner SUNIT PANDYA	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/23/2008 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically in claim 6, lines 7-9, state "a projection protruding outwardly from the front side, and from both of the upper and lower parts of the front side, of the cabinet, and located between the upper and lower parts of the front side of the cabinet", wherein the examiner cannot comprehend what the applicant claims to be patentable feature in the said claim, henceforth said claim will be given broadest reasonable claim interpretation. Wherein the examiner believes that the applicant is claiming a projection protruding outwardly from the front side of the cabinet, supported from both upper and

lower parts of the front side, and wherein the display is located between the said upper and lower parts of the said cabinet.

While features of an apparatus may be recited either structurally or functionally, claims directed to an **apparatus must be distinguished from the prior art in terms of structure rather than function**. A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. (See *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987), *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997), *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971), *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959), and MPEP 2114).

The instant case claim 6 includes limitations directed to the intended operation of an apparatus rather than solely modifying the structure of the claimed apparatus. If the Applicant intends for these limitations to be considered as possible patentable distinguishing features of their claimed invention they must be appropriately presented within the confines of a method type claims. For the purposes of this action these limitations have been correlated to the prior art of record for the purposes of further prosecution. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6, 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wurz et al. (US Patent 6,102,394) and further in view of Takemoto et al. (US Patent 5,941,774).

Claim 6: Wurz et al. teaches a gaming machine comprising, a cabinet having a front side facing a player playing a game (figure 3), a game display at an upper part of the cabinet for displaying an image during game play (figure 3). Wurz et al. also teaches of an opening on the lower side of the front of the cabinet (figure 3, element 42), a projection protruding outwardly from the front side of the cabinet, supported from both upper and lower parts of the front side, and wherein the display is located between the said upper and lower parts of the said cabinet (figure 3, col. 3: 40-45). Wurz et al. also teaches of a transparent plate covering an opening, figure 3, plate 44, is a transparent plate, located between the game display and the opening, wherein the plate is located in such a way that it would create an obstacle thus making it difficult seeing

the opening 42, in figure 3 by the player. Wurz et al. also teaches of a container disposed within the cabinet having an open end opposite to the transparent plate and accommodating plurality of display or buttons so that they are visible (figure 4), and Wurz et al. also teaches of a rear lid to apply pressure, thus urging the display to be coerced forward on the gaming machine (figure 5). Wurz et al. however fails to teach of plurality of counters, wherein each counter display includes a respective display section for displaying a numerical value that is updated each time a game is played.

In an analogous art, Takemoto et al., who teaches of a gaming system and a gaming house management system, teaches a plurality of counter displays including display sections for displaying numerical values changing according to a state of a game (col. 5: 11-19).). It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Wurz et al., to implement plurality of counter displays as taught by Takemoto to allow players informed during the game play (col. 5: 20-35).

Claim 8: Wurz et al. teaches of the projection including a control panel oblique to the front side of the cabinet and including a plurality of operating buttons for operating the gaming machine (figure 3).

Claim 9: Wurz et al. teaches of a sponge like resilient pad disposed between the rear lid and the plurality of counter displays for transmitting pressure from the rear lid to the counter or buttons (figure 5, wherein element 46, is a spacer that acts as a resilient pad, or the spring shown, element 54, performs above noted function just as effectively).

Claim 10: The combination of Wurz et al. and Takemoto et al. teaches of plurality of counter displays accommodated in the container are arranged in a row (figure 3 of Wurz et al.).

Claim 11: Wurz et al. teaches that the container is detachably attached to the cabinet from within (figure 4).

Claim 12: Wurz et al. teaches of the projection being protruding outwardly from the control panel, including a control panel oblique to the front side of the cabinet and including a plurality of operating buttons for operating the gaming machine (figure 3).

Response to Arguments

Applicant's arguments with respect to claims 6, 8-12 have been considered but are moot in view of the new ground(s) of rejection.

Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUNIT PANDYA whose telephone number is (571)272-2823. The examiner can normally be reached on M-F 8 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714

SP